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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,046	09/12/2003	Francis A. Benevento II	034901-0304947	6750

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EXAMINER

HADIZONOOZ, BANAFSHEH

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/661,046	Applicant(s) BENEVENTO, FRANCIS A.	
	Examiner Banafsheh Hadizonooz	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

In response to the amendment dated 11/30/2005, claims 32-55 and newly added claims 56-70 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32-40, 42-52, 54-55 and 60-70 are rejected under 35 U.S.C. 102 (b) as being anticipated by Mortimer et al. (US 6,091,930).

1. [Claims 32, 33, 34, 44, 45, 46, 58, 59, 68]: Regarding claims 32, 33, 44, 45, 46, 58, 59 and 68, Mortimer discloses storing at least one document (i.e. Knowledge base) in a storage medium of a device (i.e. student CITbook). See Col.7: 1-13. Mortimer discloses displaying (i.e., presentation sequence). See Col.7: 14-16, 27-31. Mortimer also discloses generating at least one modification (i.e. notes) to the at least one displayed document created by a user of the device. , Wherein at least one modification is displayed to the user as an integral part of the at least one document. See Col.7:27-31. Mortimer discloses storing at least one

modification separate (i.e., implied by "links") from the at least one document in the storage medium so that the at least one modification can be separately categorized, searched, or retrieved and correlating the at least one document and the at least one modification. See Col. 7: 27-31 and Col. 17: 67-Col. 18:6. Mortimer discloses categorizing the at least one document in automatic mode where the at least one document is automatically categorized by labeling the modification using an automatically generated label (i.e. elementary level...); See Col.2: 53-56; or manual mode where data is received from a user that identifies a category with which the at least one document is correlated. See Col.7: 27-31.

2. [Claims 35, 47]: Regarding claims 35 and 47, Mortimer discloses a system wherein the storage medium (i.e. memory unit) includes a plurality of documents (i.e. subjects). See Col. 2:47-50, Col. 9: 35-50.
3. [Claims 36, 39, 48, 51]: Regarding claims 36, 39, 48 and 51, Mortimer discusses generating a personalized summary (i.e. outline) of an experience based on categorization of the at least one modification made to the documents. See Col.17: 67- Col.18:3.
4. [Claims 37, 49]: Regarding claims 37 and 49, Mortimer discloses accessing at least one resource (e.g. knowledge in the areas in which they may be lacking sufficient background information to comprehend the material presented). See Col.7: 16-19.

5. [Claims 38, 50, 64]: Regarding claims 38 and 50 and 647 Mortimer discloses receiving a series of modifications (i.e. changes) wherein the series of modifications are made by a third party (i.e. professor). See col. 14: 58-61.
6. [Claims 40, 52]: regarding claims 40 and 52, Mortimer discloses transforming the at least one document from one form to another form (i.e., customized form). See Col.2:35-40.
7. [Claims 42, 54]: regarding claims 42 and 54, Mortimer discusses generating at least one outline of the at least one document based on the at least one modification made to the document. See Col. 17: 67- Col. 18: 1-7.
8. [Claims 43, 55]: Regarding claims 43 and 55, Mortimer discloses generating a review (i.e. well- accepted data) of the at least one document based on the at least one modification. See Col. 7: 50-60.
9. [Claims 60]: Regarding claims 60, Mortimer discloses storing a plurality of documents (i.e. subjects) in a storage medium of a device (i.e. memory unit). See Col.2: 48-51. Mortimer discloses displaying (i.e. presentation sequence). See Col.7: 14-16, 27-31. Mortimer also discloses generating a modification (i.e. notes) to the at least one displayed document created by a user of the device. , Wherein at least one modification is displayed to the user as an integral part of the at least one document. See Col.7:27-31. Mortimer discloses storing at least one document (i.e. Knowledge base) in a storage medium of a device (i.e. student CITbook). See Col.7: 1-13. Mortimer discloses storing at least one modification separate (i.e., implied by "links") from the at least one document in the storage medium so that

the at least one modification can be separately categorized, searched, or retrieved and correlating the at least one document and the at least one modification. See Col. 7: 27-31 and Col. 17: 67-Col. 18:6. Mortimer discloses correlating the modification to each of the plurality of documents to the associated document in which the modification is generated. See Col. 5: 13-19. Mortimer also discloses generating a summary comprising the modification to each of the plurality of documents. See Col 17: 67- Col.18:3.

10. [Claims 61, 62, 63]: Regarding claims 61, 62 and 63, Mortimer discloses an individual learning method, wherein generating the summary comprises organizing the modification to each of the plurality of documents according to predefined hierarchy (i.e. chapters) wherein the predefined hierarchy corresponds to a set of categories (i.e. knowledge level of the subject) of each of the plurality of documents, wherein the plurality of documents relates to a common subject matter (i.e. corresponds to one of the plurality of subject matters. See Col. 2: 52-61.
11. [Claims 66, 67]: Regarding claims 66 and 67, Mortimer discloses categorizing the each of the plurality of documents (i.e. input data), and categorizing the modifications to each of the plurality of documents (i.e. topics). See Col. 8: 40-50.
12. [Claims 69, 70]: Regarding claims 69 and 70, Mortimer discloses storing a plurality of other documents in a storage medium (i.e. memory unit) of a device, said plurality of other documents comprising a different subject matter than a subject matter of the first mentioned plurality of documents. See Col.2: 48-51. Mortimer

discloses displaying (i.e. presentation sequence). See Col.7: 14-16, 27-31. Mortimer also discloses generating a modification (i.e. notes) to the at least one displayed document created by a user of the device. , Wherein at least one modification is displayed to the user as an integral part of the at least one document. See Col.7:27-31. . Mortimer discloses storing at least one document (i.e. Knowledge base) in a storage medium of a device (i.e. student CITbook). See Col.7: 1-13. Mortimer discloses storing at least one modification separate (i.e., implied by "links") from the at least one document in the storage medium so that the at least one modification can be separately categorized, searched, or retrieved and correlating the at least one document and the at least one modification. See Col. 7: 27-31 and Col. 17: 67- Col. 18:6. Mortimer discloses correlating the modification to each of the plurality of documents to the associated document in which the modification is generated. See Col. 5: 13-19. Mortimer also discloses generating a summary comprising the modification to each of the plurality of documents. See Col 17: 67- Col.18:3. Mortimer also discloses a learning method, wherein the plurality of other documents (i.e. input data) relates to a common subject matter. See Col.2: 53- 58.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41, 53, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mortimer in view of Takeda et al. (US 5,349,368).

[Claims 41, 53, 56, 57]: Regarding claims 41, 53, 56 and 57, Mortimer discloses all the features of the above-mentioned claims. Mortimer does not expressly disclose translating one document from one language to another language. However, Takeda teaches such in Col.2: 54-57. Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to incorporate translating feature of Takeda's invention into the system of Mortimer in order to attract more users to the system of the present invention.

Response to Arguments

Applicant's arguments filed on 11/30 2005 have been fully considered but they are not persuasive. The applicant argues that Mortimer does not disclose a system wherein the manual and automatic categorization of the text of the subject matter is performed. Mortimer expressly discloses the manual and automatic categorization features of the subject matter in his invention. See Col. 8: 33-37. In Mortimer's invention the notes added to the margins by the students are in fact the modifications, which are later categorized manually or automatically. In response to the applicant's argument

regarding claims 35 and 47, Mortimer discusses a storage medium where a plurality of documents and a plurality of modifications can be stored. See Col. 9: 35-50.

Regarding claim rejections- 35 USC 103, as discussed above, all the features disclosed in claims 32 and 44 which claims 41 and 53 are depended upon are included in Mortimer's invention. In addition, Takeda discloses a system wherein one sentence is translated from one language to another language. The combination of the features of Mortimer's and Takeda's inventions overcomes the deficiencies in Mortimer et al. According to MPEP; 2143, the references do not have to suggest or include the motivation to combine the references teachings; they only must teach all the claims limitations. The knowledge to combine the two references can be generally available to one of ordinary skill in the art with a reasonable expectation for success. In claims 41 and 53, such motivation and expectation is understood by one of ordinary skill in the art.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mcgreavy (US 6,823,333)
 - Categorization

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Banafsheh Hadizonooz whose telephone number is 571-272-1242. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszweski can be reached on (571) 272- 6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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BH


KATHLEEN MOSSER
PRIMARY EXAMINER